REMARKS

In the Office Action mailed June 12, 2006, the Examiner has rejected claims 2-10, 12-16 and 18-28 under 35 U.S.C. § 103(a) as being unpatentable over the Miracle et al. U.S. Patent No. 5,576,282 (Miracle et al.'282) in view of the Perkins U.S. Patent No. 4,153,968 (Perkins '968) and further in view of McAllise et al. 5,500,977. This rejection is respectfully traversed. Applicant requests reconsideration of the rejection in view of the remarks and arguments as set forth below.

Insofar as Applicants understand the rejection, claims 2-10, 12-16 and 19-28 are rejected over the combination of the Miracle et al.'282 in view of the Perkins '968 references. Further, claim 18 is rejected over the combination of Miracle et al. '282 in view of McAllise et al. '977 and perhaps in combination with Perkins '968. It is not clear whether the Examiner has applied all three of these references against claim 18. It is, however, clear that the Examiner has only applied Miracle et al. '282 and Perkins '968 against claim 21 and the claims dependent therefrom.

The rejection of the claims with the current Office Action is essentially the same as the rejection of the very same claims in the Office Action mailed January 9, 2006. Applicant incorporates by reference all of the arguments made in response to the January 9, 2006, Office Action in the Response to Office Action filed April 4, 2006. Applicants believe that the Examiner has not made a *prima facie* case for unpatentability in his alleged combination of Miracle et al. '977 in view of Perkins '968 alone or in combination with McAllise et al. '977 for all of the reasons set forth in the previous response. However, there are several points that apparently need emphasis and these points are set forth below.

The Rejection of Claim 21 and Claims Dependent Therefrom is Contrary to the Decision of the Board of Patent Appeals and Interferences.

Claim 21 was the subject of an Appeal to the Board of Patent Appeals and Interferences. The examiner had rejected this claim over the Miracle et al. '977 patent in view of the Ligman U.S. Patent No. 5,555,595 (Ligman '595 patent) or the Sham U.S. Patent No. 5,386,612 (Sham '612 patent). In its decision which was mailed August 17, 2005, the Board of Patent Appeals and

Interferences (BPAI) held that the Miracle '282 patent was properly combined with Sham '612 or with Ligman '595 as a prior art teaching of incorporating the Miracle et al. '282 oxidizing composition in either the Sham '612 or Ligman' 595 extraction cleaners. Thus, the Miracle et al. '282 and the Sham '612 or the Ligman '595 references could be combined to disclose the addition of a cleaning solution with an oxidizing agent into the solution tanks of the Sham '612 or Ligman '595 extractors. In particular, the BPAI held that "it would have been prima facie obvious for one with ordinary skill in the art to effect the carpet shampooing method envisioned by Miracle et al. '282 by a carpet cleaning machines of the type taught by Ligman or Sham." The BPAI Opinion, page 4. Applicants do not dispute this holding of the BPAI.

Applicants believe that the Perkins '968 reference discloses nothing more than what is disclosed in the Sham '612 or the Ligman '595 references with respect to the claimed invention. The Examiner has not articulated any differences between the Perkins '968 reference and either the Sham '612 or the Ligman '595 references other than the disclosure in the Perkins '968 reference that "two or more reservoirs could be use alternatively1 under different conditions." Perkins '968, col. 9, lines 3-6. If there are any relevant differences between these references as related to the claims in this application, Applicants have missed the distinction. The Examiner is invited to enlighten Applicants as to what differences there are between these three references as they apply to the claims in this application. It is Applicants' position that the alleged combination of Perkins '968 and Miracle et al. '282 disclose nothing more than the Examiner's old combination of Miracle et al. '282 and Sham '612, and Ligman '595. Therefore, Applicants believe that the decision of the Board of Appeals with respect to the claims in this application controls the law of this case.

Turning now to the decision of the BPAI as it relates to the claims in this application, the Examiner's attention is invited to the Board's decision which reads in relevant part as follows:

> . . . However, the § 103 rejection of claims 8, 11, 14, 17, 18 and 21 cannot be sustained as fully explained hereinafter. (BPAI Opinion, page 3)
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> . . . .

1 The term "alternate" is not an attorney argument. It is a fact. There is not disclosure in Perkins '968 of using separate tanks in sequence. That is a fact. Not an attorney opinion.

> We reach a different determination with respect to claims 8, 11, 14, 17, 18 and 21. (BPAI Opinion, page 6)
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> . . .
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> Similarly, the references applied by the Examiner contain no teaching or suggestion of "the step of heating the cleaning solution before the admixing step the admixture" as recited in separately grouped claims 11, 17 and 21. Apparently in reference to these claims, the Examiner states "The order of mixing will not be given patentable weight in the absence of showing superior or unexpected results" (Answer, page 13). This wholly inappropriate statement is directly contrary to long-established precedents. *See, for example, In re Wilson*, 424F2nd 1382, 1385, 1 65USPQ 494, 496 (C.C.P.A 1970) (All words in a claim must be considered in judging the patentability of that claim against the prior art.) Under these circumstances, we again are compelled to hereby reverse the Examiner's § 103 rejection vis-à-vis claims 11, 17, and 21 as being unpatentable over Miracle in view of Ligman or Sham. (BPAI, page 7-8).

The Examiner has apparently not understood that the decision of the BPAI with respect to the Examiner's rejection of claim 21 is controlling. In other words, the Examiner cannot continue to reject claims on the same grounds that the Board held were inappropriate. The examiner is bound to follow the Board's decision. The Examiner has either not understood the Board's decision in this matter or has simply chosen to ignore it.

The rejection of claim 21 and the claims dependent therefrom on the Miracle et al. '282 in view of Perkins '968 is the same rejection that the Examiner was reversed on by the Board of Appeals in its decision. There is no difference between of the Sham '612, Ligman '595 and Perkins '968 references with respect to the subject matter of claim 21. And the Examiner has articulated no differences between these references. The Examiner is bound to heed the admonition of the BPAI in its reversal of the Examiner on essentially the same grounds with respect to claim 21.

As emphasized by the BPAI in its decision, "the references applied by the Examiner contain no teaching or suggestion of 'a step of heating the cleaning solution before the admixing step to heat the admixture' as recited in separately grouped claims 11, 17, and 21." The Examiner's alleged combination of McAllise et al. '977 and Perkins '968 contains no teaching or suggestion of this claimed step. The Examiner is reminded that all words in a claim must be considered in judging the patentability of that claim against the prior art. *See, In re Wilson*,

424F2nd 1382, 1385, 1 65USPQ 494, 496 (C.C.P.A 1970). The Examiner is invited to articulate where in this alleged combination this step is disclosed or suggested.

Claim 18 is Not Met by Examiner's Alleged Combination of References

Claim 18 is the other independent claim in this application. It differs from claim 21 in that it does not call for the step of heating the cleaning solution before the admixing step to heat the admixture but calls for the step of mixing the admixture with heated air to heat the admixture; and heating the air before the step of mixing with the admixture with heated air. The Board found that these limitations were not found in the Examiner's combination of Miracle et al. '282 in view of Sham '612 or Ligman '595. However, in its Decision, the Board made the following comment as a footnote on page 7 of the Board's Opinion;

> On page 27 of the Specification, the Appellants describe the heated air feature of these claims by incorporation by reference to U.S. Patent No 5.500,977 to McAllise et al. Upon return of this application to the jurisdiction of the examining core, the Examiner and the Appellants should consider and resolve whether the claims under consideration patentably distinguished over the combined teachings of Miracle and McAllise et al. patent (e.g. see Figures 8b and 11a, the paragraph bridging columns 8 and 9 as well as lines 11-26 in column 12). (BPAI Opinion at page 7).

In his rejection, the Examiner has now cited the McAllise et al. '977 reference in combination with the Miracle et al. '282 and Perkins '968. It should be noted initially that the Board could have rejected these claims 8, 14 and 18 as unpatentable over Miracle et al. '282 in view of McAllise et al. '977 but declined to do so, suggesting that the Examiner and Appellants give consideration as to whether the claims patentably distinguish over the combined teaching of Miracle et al. '282 and McAllise et al. '977. As indicated above, the Miracle et al. '282 and the Perkins '968 references disclose that nothing more than was held to be taught by the alleged combination of McAllise et al. '282, Sham '612 and Ligman '595. McAllise et al. '977 discloses that "warm moist exhaust air is discharged through a discharge nozzle to atomize the cleaning fluid which is then applied to the surface." Applicants can find no disclosure in the McAllise et al. '282 patent as to the source of the "warm, moist exhaust air from motor fan 610 is discharged

through district nozzle 65." Therefore, it is not understood what is meant by McAllise et al. '977 referring to "warm, moist exhaust air". The term "warm" is a relative term and is not defined in the McAllise et al. '977 patent. The term "warm" can be used in different contexts. For example, air at 40° could be considered to be warm with respect to some freezing temperatures. In the context of the McAllise et al. '977 patent, "warm, moist air" might be considered to the ambient temperatures or something slightly above ambient temperatures because there is no teaching in McAllise et al. '977 how one achieves "warm, moist air". The Examiner has offered no explanation of how "warm, moist air" can be produced in the McAllise et al. '977.

The Examiner contends that "McAllise et al. specifically teach and discloses that the air is warmed by motor 610 prior to admixing with the cleaning solution at the discharge nozzle (col. 12, lines 11-26)." The Examiner is clearly wrong in his interpretation of the McAllise et al. '977 patent. There is nothing in the cited passage in the McAllise et al. '977 patent that supports the Examiner's conclusion. This passage merely states that the motor *fan* 610, not the motor, discharges the air through nozzle 65. The cited passage discloses that the air from the recovery tank 50 is drawn to the inlet plenum 619 of the motor fan via stand pipe 672 and 572. This passage is clearly shown in Figs. 2, 5 and 6. This air completely avoids the motor 628 (see Fig. 2). Examiner's attention is further directed to col. 3, lines 33-39 and Figs. 2, 6 and 8B, which disclose a separate cooling path for the motor, which is common in extractors. Therefore, it is quite clear from a reading of McAllise et al. '977 that there no heating of the exhaust air by the motor 628.

At best, the Examiner's alleged combination of references would show mixing warm moist air with a cleaning solution but that disclosure in and of itself does not meet the limitations of claim 18 which states in relevant part as follows:

mixing the admixture with heated air to heat the admixture; ...

There is no disclosure in the Examiner's alleged combination of heating the admixture with heated air. It is quite possible and likely from the disclosure of McAllise et al. that a

solution may be warmer than that of the "warm, moist air" disclosed in McAllise et al. '977. Further, and more importantly, the Examiner's alleged combination does not disclose the step of:

heating the air before the step of mixing the admixture with heated air.

Contrary to the Examiner's faulty interpretation of the McAllise et al. '977 patent, the McAllise et al. '977 patent either of these claim limitations in his rejection.

Once again, the Examiner is admonished to heed the direction of the BPAI Opinion "all words in a claim must be considered in judging the patentability of that claim against the prior art". (BPAI Opinion, page 80)

CONCLUSION

In view the foregoing, it is submitted that all of the claims in this application are in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

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